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<div>7590 04/21/2009</div> <div>Paul A. Leipold Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201</div> <div>EXAMINER SCHWARTZ, PAMELA R</div> <div>ART UNIT PAPER NUMBER</div> <div>1794</div> <div>MAIL DATE DELIVERY MODE</div> <div>04/21/2009 PAPER</div>				

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL B. MERKEL, GARY N. BARBER,
ALAN R. PITT, and TREVOR J. WEAR

Appeal 2008-5705
Application 10/622,421
Technology Center 1700

Decided:¹ April 21, 2009

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
ADRIENE LEPIANE HANLON, *Administrative Patent Judges*.

HANLON, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

The Appellants request rehearing of a DECISION ON APPEAL
dated December 17, 2008, affirming the following rejections:

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

(1) Claims 1, 4, 6-8, 11, 12, 22-29, and 34 under 35 U.S.C. § 103(a) as unpatentable over Nakano,² either alone or in combination with Tsuchiya.³

(2) Claims 1, 4, 6-8, 11, 12, and 22-34 under 35 U.S.C. § 103(a) as unpatentable over the combination of Nakano, Tsuchiya, and Niu.⁴

(3) Claims 1, 4, 6-8, 11, 12, 22-32, and 34 under 35 U.S.C. § 103(a) as unpatentable over Tsuchiya.

(4) Claims 1 and 33 under 35 U.S.C. § 103(a) as unpatentable over the combination of Tsuchiya and Nakano.

A request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the briefs are not permitted in the request for rehearing except as permitted by 37 C.F.R. § 41.52(a)(2) and (a)(3). *See* 37 C.F.R. § 41.52(a)(1) (2007).

Discussion

In the Request for Rehearing, the Appellants do not point to any error in the Board's Decision affirming rejections (1)-(3). Rather, the Appellants focus on the rejection of claim 33 under §103(a) over the combination of Tsuchiya and Nakano, i.e., Issue 4. *See* Request 1.⁵

In particular, the Appellants argue:

In the Analysis section of the Decision, at page 12, the last paragraph before the "Conclusions of Law," it is stated "The portion of Tsuchiya relied on by the Appellants relates to

² US 6,919,109 B2 issued to Nakano et al. on July 19, 2005.

³ US 6,495,242 B1 issued to Tsuchiya et al. on December 17, 2002.

⁴ US 6,689,433 B2 issued to Niu et al. on February 10, 2004.

⁵ Request for Rehearing dated February 16, 2009.

a comparative example. See Tsuchiya 11:1-3.” This statement suggests a misunderstanding of the reference as a whole.

Turning to Tsuchiya, at 13:66-67; 14:63-64; 15:27; and 15:66, it is clear that the statement about pH value in the reference examples applies not only to the comparative example but also to all of the working examples of the invention. Thus, all of the “preferred embodiments” of Tsuchiya are obtained using materials of pH 2.6 and 2.3 to provide a dispersion that is strongly acidic.

Request 1.

Comparative Example 1 describes a method of making a silica Dispersion B1. Tsuchiya 11:2-26. The dispersion, in turn, is used to prepare four types of coating compositions for coating an ink-jet recording sheet. Tsuchiya 11:37-12:22.

Although Tsuchiya does use acidic materials (i.e., aqueous dispersion A1 having a pH of 2.6 and aqueous solution C1 having a pH of 2.3) to prepare silica Dispersion B1, Tsuchiya does not disclose the pH of Dispersion B1. *See* Tsuchiya 11:2-26. Moreover, the Appellants have failed to direct us to any evidence establishing that Dispersion B1 is in fact “strongly acidic.” *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965) (“Argument in the brief does not take the place of evidence in the record.”).

In addition, to the extent that Dispersion B1 is employed in Tsuchiya Examples 1-4, the Appellants have failed to direct us to any disclosure in Tsuchiya identifying the surface pH of an ink-absorbable layer prepared according to the disclosed invention. *See* Tsuchiya 13:65-16:20; *see also* Ans. 13⁶ (“it is noted that the pH values appellants are reciting from

⁶ Examiner’s Answer dated September 20, 2007.

Tsuchiya et al. do not represent the ‘surface pH’ of the image receiving layer moistened with water, which is what is recited by claim 33”).

Finally, regardless of the pH of the ink-absorbable layer of Tsuchiya, the Examiner found that Nakano discloses that the surface pH of an image receiving or ink-absorbable layer may be adjusted from 3 to 8 to improve resistance to yellowing discoloration. Nakano 16:45-50. The Examiner concluded that it would have been obvious to one of ordinary skill in the art to adjust the surface pH of the image receiving layer in Tsuchiya as disclosed in Nakano to improve resistance to yellowing discoloration. *See* Decision 11.⁷

The Appellants recognize that “Nakano mentions a pH upper limit of 8.” Nonetheless, the Appellants argue that “[t]he gist of all of the references is that an acidic dispersion is *preferred*.” Request 2 (emphasis added).

As explained in the DECISION ON APPEAL, “all disclosures of the prior art, including unpreferred embodiments, must be considered.” *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976). In this case, Nakano expressly discloses a pH range of from 3 to 8. *See In re Malagari*, 499 F.2d 1297, 1303 (CCPA 1974) (claimed invention is rendered *prima facie* obvious by prior art reference disclosing a range that touches the claimed range). We find that it would have been within the skill of the ordinary artisan to adjust the surface pH of the ink-absorbable layer of Tsuchiya to a value within this range. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (a person of ordinary skill is also a person of ordinary creativity).

⁷ DECISION ON APPEAL dated December 17, 2008.

Conclusion

The Appellants' Request for Rehearing has been granted to the extent that the DECISION ON APPEAL dated December 17, 2008, has been reconsidered in light of the Appellants' arguments. However, the Request is denied because we decline to modify the Decision in any respect.

REHEARING DENIED

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PAUL A. LEIPOLD
PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER NY 14650-2201